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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,663	12/30/2003	Wolfgang Kalthoff	13907-062001 / 2003P00406	1562
32864	7590	08/30/2006	EXAMINER	
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			CHASE, SHELLY A	
			ART UNIT	PAPER NUMBER
			2133	

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/747,663

**Applicant(s)**

KALTHOFF ET AL.

**Examiner**

Shelly A. Chase

**Art Unit**

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 10-18 is/are rejected.
- 7) ☒ Claim(s) 3-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.


### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SHELLY CHASE**  
**PRIMARY EXAMINER**

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8-22-06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1 to 18 are presented for examination.

#### ***Information Disclosure Statement***

2. The references listed in the information disclosure statement submitted on 5-13-2004, 8-3-2004, 12-21-2004, 5-13-2005, 6-24-2005, 1-17-2006, and 7-3-2006 have been considered by the examiner (see attached PTO-1449).

#### ***Specification***

3. The disclosure is objected to because of the following informalities: the disclosure is referring to the same element in the figures with different names specifically page 4, lines 10 to 13.

Appropriate correction is required.

#### ***Claim Objections***

4. Claim 12 is objected to because of the following informalities: please change "the system" to ---a system--- recited on line 3.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 12 to 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is indefinite because the phrase "the computer program product of claim, wherein" the examiner is unsure if claim 12 is a dependent or independent claim. Claims 13 to 18 are rejected due to their dependency on a rejected base claim.

### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10 and 12 are rejected under 35 U.S.C. 101 because the preamble of the claims recites intended use and the body of the claim is directed to a program per se. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technology art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subjected matter under 35 U.S.C. 101. Claims 11 and 13 to 18 are also rejected due to their dependency on a rejected base claim.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2133

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1 to 2 and 10 to 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Croke et al. (USP 6842881 B2).

Claim 1:

Croke teaches a rule base system and method for automatically generating photomask orders, the method comprising: a template in which data is entered by a user ("receiving data from a first enterer") (see col. 7, lines 15 to 25) and a first set or rules are establish to ensure the user input the corrects data ("accepting data received from the first data enterer into the system if the data are entered in a format compliant with a first set of rules") (see col. 7, lines 25 et seq.). Croke also teaches that addition is received according to the "Array Registration" template ("second data enterer") wherein the data in the "Array Registration" is needed to complete the order and is entered after the data in the template (see col. 9, lines 35 to 45).

Croke further teaches that data is entered in the "Array Registration" template according to a second set of rules (see col. 9, lines 45 et seq.), which reads on "accepting first additional data received from the second data enterer into the system if the data are entered in a format compliant with a second set of rules." Croke teaches that the templates, orders and rules are stored in a database (see col. 8, lines 49 et seq.).

As per claim 2, Croke teaches that the data entered by the user must comply with the first and second set of rules (see col. 9, lines 55 to 68).

**Claim 10:**

Croke teaches a rule base system and method for automatically generating photomask orders, the method comprising: a template in which data is entered by a user ("receiving data from a first enterer") (see col. 7, lines 15 to 25) and a first set of rules are established to ensure the user input the correct data ("accepting data received from the first data enterer into the system if the data are entered in a format compliant with a first set of rules") (see col. 7, lines 25 et seq.). Croke also teaches that addition is received according to the "Array Registration" template ("second data enterer") wherein the data in the "Array Registration" is needed to complete the order and is entered after the data in the template (see col. 9, lines 35 to 45).

Croke further teaches that data is entered in the "Array Registration" template according to a second set of rules (see col. 9, lines 45 et seq.), which reads on "accepting first additional data received from the second data enterer into the system if the data are entered in a format compliant with a second set of rules." Croke teaches that the templates, orders and rules are stored in a database (see col. 8, lines 49 et seq.). Croke also teaches that the rules and templates are implemented in a software-based application installed on a computer (see col. 10, lines 44 et seq.).

As per claim 11, Croke teaches that the data entered by the user must comply with the first and second set of rules (see col. 9, lines 55 to 68).

***Allowable Subject Matter***


10. Claims 3 to 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelly A. Chase whose telephone number is 571-272-3816. The examiner can normally be reached on Mon-Thur from 8:00 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571-272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**SHELLY CHASE**  
**PRIMARY EXAMINER**